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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,049	01/23/2002	Markus Noller	16787-2	5241

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EXAMINER

DEL SOLE, JOSEPH S

ART UNIT PAPER NUMBER

1722

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,049

Applicant(s)

NOLLER ET AL.

Examiner

Joseph S. Del Sole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003 and 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris (4,721,589).

Harris teaches a device, that corresponds to the instant device, for extruding compounds, having at least one feed instrument 14 for feeding a compound through a channel 12 to a die 27, a sensing instrument 34, 35 being provided at the channel or at the die in order to determine at least one measured variable related to the viscosity of the compound, the feed instrument 14 and the die 27 being configured such that the feed instrument 14 provides a delivery pressure that oscillates over time at a given frequency, and the die 27 provides a flow resistance controlled by a gear pump 24 which oscillates at the same frequency in order to maintain the compound viscosity (col. 10, line 34, to col. 11, line 18). The measured variable is the pressure of the compound (col. 7, lines 4-7). The sensing instrument is operatively coupled to a control instrument 36. The control instrument 36 is capable of controlling the feed instrument 14, as a function of at least one measured value determined by the sensing instrument, in such a way that the exit velocity of the compound from the die fluctuates minimally, i.e., by maintaining viscosity.

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The Examiner notes that the intended use of the apparatus, in this instance extruding "bakery and confectionery compounds", does not further limit the structure of the apparatus because it is merely a process limitation. Intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530. Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666. Inclusion of the material worked upon by a structure being claimed does not impart patentability to the claims, *In re Otto et al.*, 136 USPQ 458. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitation of that claimed, *Ex parte Masham*, 2 USPQ 2d 1647. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (4,721,589) in view of Balk (4,797,079).

Harris discloses the apparatus substantially as claimed except for the measured variable being the flow rate of the compound.

Balk discloses an extrusion apparatus including a flow rate detector 13 for regulating a feed instrument 11 providing a compound to a die 1.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the measured variable of Harris to be the flow rate of the compound because such a measured flow rate would provide an alternative variable for controlling the feed instrument as disclosed by Balk.

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7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (4,721,589) in view of Straumanis (3,890,078).

Harris discloses the apparatus substantially as claimed except for the device including a transport instrument for removing the compound extruded from the die, the control instrument being capable of controlling the transport instrument, as a function of at least one measured value determined by the sensing instrument, in such a way that the transport velocity of the transport instrument corresponds to the exit velocity of the compound from the die.

Straumanis discloses an extrusion device which includes a transport instrument 15 for removing a compound extruded from a die 16. A sensing instrument for sensing head pressure is operatively coupled to a control instrument 31. The control instrument 31 is capable of controlling the transport instrument 15, as a function of at least one measured value, i.e., head pressure, determined by the sensing instrument, in such a way that the transport velocity of the transport instrument corresponds to the exit velocity of the compound from the die, i.e., to maintain the thickness of the extrudate (col. 4, line 56, to col. 12, line 11).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the apparatus of Harris with a transport instrument and to make the control instrument capable of controlling the transport instrument, as a function of at least one measured value determined by the sensing instrument, in such a way that the transport velocity of the transport instrument corresponds to the exit

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velocity of the compound from the die, because such a modification would provide enable the product to be removed with a uniform thickness as disclosed by Straumanis.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (4,721,589) in view of Abe (5,855,830).

Harris discloses the apparatus substantially as claimed except for the device including a rotary instrument having at least one rotatable die, the control instrument being capable of controlling the rotary instrument, as a function of at least one measured value determined by the sensing instrument, in such a way that the exit velocity of the compound from the die fluctuates minimally.

Abe discloses an extrusion device including a rotary instrument having at least one rotatable die 9. A sensing instrument 13 is operatively coupled to a control instrument 15. The control instrument 15 is capable of controlling the rotary instrument 9, as a function of at least one measured value determined by the sensing instrument 13, in such a way that the exit velocity of the compound from the die fluctuates minimally, i.e., for uniform product shape (col. 1, lines 10-22; col. 4, line 1, to col. line 3).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the device of Harris to include a rotary instrument having at least one rotatable die, the control instrument being capable of controlling the rotary instrument, as a function of at least one measured value determined by the sensing instrument, in such a way that the exit velocity of the compound from the die fluctuates minimally, because such a modification is known in the extrusion art as disclosed by Abe and would provide a uniform shaped product.

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9. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (4,721,589) in view of LaSpisa (4,107,246).

Harris discloses the apparatus substantially as claimed except for the feed instrument being connected through a plurality of channels to a die having a plurality of outlet openings.

LaSpisa discloses a feed instrument being connected through a plurality of channels to a die having a plurality of outlet openings in order to make multiple products.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the feed instrument of Harris to be connected through a plurality of channels to a die having a plurality of outlet openings because such a modification would enable multiple products to be produced, as disclosed by LaSpisa.

Response to Arguments

10. Applicant's arguments filed 11/5/03 have been fully considered but they are not persuasive.

The Applicant argues that, by amendment, all claims have been limited to the field of bakery and confectionary compounds and that such a limitation will contribute to distinguishing the present invention over the prior art.

The Examiner disagrees. As discussed above, an apparatus claim cannot be limited by the intended use of the materials processed by an apparatus. The claims as amended do not distinguish over the prior art.

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The Applicant further makes arguments related to the problem addressed by the present invention. Nevertheless, although the problems may never have been addressed, the point is moot. The Applicant must show that structures claimed are novel, these arguments do not address apparatus limitations.

The Applicant further argues that the gear pump 24 as proposed by Harris is "obviously not adapted to compensate for pressure oscillation of the kind addressed in the present application."

While this may be true, the gear pump as claimed is not structurally differentiated from the gear pump as taught by Harris.

The claims remain rejected as set forth above.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph S. Del Sole whose telephone number is (571) 272-1130. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Joseph S Del Sole

J.S.D.
January 25, 2004


ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1800-1722

1/20/04